

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Faxed: July 16, 2003

Opposition No. 91125615

University of Southern
California

v.

University of South
Carolina

Gerard Rogers, Administrative Trademark Judge:

On February 10, 2003, the Board issued an interlocutory order that, among other things, required applicant to file a copy of its *original* answer and counterclaim. The Board was in receipt of only the answer and *amended* counterclaim, a pleading that the Board accepted as a matter of course because, by its caption, applicant was not amending the answer and the original counterclaim had not been answered and could, therefore, be amended without need of consent to the amendment by opposer.

Applicant responded by filing a copy of the answer and *amended* counterclaim, not the *original* answer and counterclaim. Thereafter, the parties completed, pursuant to the terms of the February 10 order, their briefing of

what the Board has construed as a motion for summary judgment by opposer on applicant's counterclaim.

Though the completion of briefing of opposer's motion has rendered it ready for consideration, the Board still is not in possession of a copy of applicant's *original* answer and counterclaim; the Board so informed applicant's counsel by phone. In addition, the Board informed applicant's counsel that only a \$300 fee was received for the counterclaim, when a total fee of \$1200 would be needed for applicant to seek cancellation of each of the four classes in opposer's pleaded registration.

The Board recently reminded applicant's counsel by e-mail of the still needed copy of the *original* answer and counterclaim and the still needed supplemental fee of \$900 for the counterclaim. By return e-mail, counsel stated that the necessary copy and fee had been filed; further, counsel stated that he had received a telephone call from an unidentified person at the USPTO inquiring as to what matter the submitted fee check should be allocated.¹

Though the Board has thoroughly investigated the reported mailing of the pleading and fee check, no evidence

¹ A WORD copy of the cover letter for the pleading and fee check, submitted as an attachment to counsel's e-mail, shows that it does not list the opposition number or number of the registration that is the subject of the counterclaim. Nor does the letter reveal when or how it was mailed or otherwise forwarded to the Office.

of receipt of either has been uncovered. Despite the reported phone call to counsel from the USPTO, it appears that the Finance Office's general policy is not to make phone calls regarding submitted fees, unless made by a supervisor; and the appropriate supervisor has no recollection of making such a call. Further, neither applicant's cover letter nor the enclosed copy of the pleading has been found, either in hard copy or in the Board's electronic proceeding files system, even though diligent searching has been conducted.²

Applicant, if its submitted fee check has been processed, may submit a copy of the cancelled check to establish receipt by the Finance Office of the required supplemental fee for the counterclaim. Or applicant's counsel may contact the Board to discuss what processing codes may appear on the cancelled check, so that the Board may then attempt to confirm receipt of the fee by the Finance Office.³ Or applicant may simply make a new tender

² For some time now, the Board has been working with the TTABIS system, whereby incoming documents are scanned into electronic proceeding files, so that work on proceedings can be done "on screen." Eventually, parties will be able to file documents for proceedings electronically, and they will be merged into the appropriate TTABIS proceeding file.

³ The supplemental fee, if received and processed, has not been allocated to the opposition number, or to opposer's registration (or the serial number of the application that resulted in such registration), or to applicant's involved application. A processing code on a cancelled check may reveal that the fee was inadvertently allocated to some unrelated file or proceeding.

of the fee.⁴ If applicant does not establish receipt by the Finance Office of the fee, or submit a new fee check, within **TEN days** of the date of this order, then the counterclaim will be considered only in regard to one class, specifically, the lowest numbered class, of goods in opposer's pleaded registration. Copies of this order have been faxed to both applicant's and opposer's respective counsel.

⁴ If applicant elects this option, applicant should include reference to the opposition number on its paper, along with reference to the registration that is the subject of its counterclaim.